

## REMARKS

### **1. Claim Rejections -- 35 U.S.C. § 103**

Claims 1-2, 5, 8, 16, 19-20, 23, 24, 26-27 and 30 stand rejected under 35 U.S.C. § 103(a) (“Section 103(a)”) as obvious in view of U.S. Pat. No. 6,366,696 to Hertz (“Hertz”) and further in view of U.S. Pat. App. No. 2004/0118916 to He (“He”). Claims 3, 4, 9-11, 17, 18, 25 and 28-29 stand rejected under Section 103(a) as unpatentable over Hertz and He in view of U.S. Pat. No. 6,592,033 to Jennings (“Jennings”). Claims 6 and 21 stand rejected under Section 103(a) as unpatentable over Hertz and He in view of U.S. Pat. App. No. 2003/0189098 to Tsikos (“Tsikos”). Claims 7, 12 and 22 stand rejected under Section 103(a) as unpatentable over Hertz and He in view of U.S. Pat. No. 5,497,314 to Novak (“Novak”). Finally, claims 13-15 stand rejected under Section 103(a) as unpatentable over Hertz and He in view of U.S. Pat. No. 6,260,023 to Seevers (“Seevers”).

An invention is unpatentable under Section 103(a) “if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.” 35 U.S.C. § 103(a).

To establish a *prima facie* case of obviousness, three criteria must be met. “First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2142.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be “found in the prior art, and not based on applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

A “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under Section 103(a). *Id.* As Applicant fails to find mention or suggestion of each claimed limitation, and as one skilled in the art would not be motivated by the cited references to modify or combine the references to produce the present invention, Applicant respectfully submits that the claimed invention is not obvious in view thereof.

Applicant’s independent claim 1, as amended, recites “an association module configured to identify the item in a database based on the visual characteristic [and] a verification module configured to verify the identity of the item based on the coded identifier.” Applicant’s invention thus relies on visual characteristic information to obtain preliminary search results which may then be verified by the coded identifier. In this manner, the identity of the product may be more accurately determined than if the coded identifier, which may be improperly placed and thus entirely inaccurate, is used as the primary criterion.

Indeed, one objective of the present invention is to avoid fraudulent purchases resulting from a mismatch between the coded identifier read and the product purchased. By basing search results on physical characteristics of the product rather than characteristics of the coded identifier, the present invention may accurately identify a

purchased product, despite circumstances where the reader module reads a coded identifier that does not correspond to such product. Applicant finds no mention or suggestion of this limitation in any cited reference, alone or in combination, and thus submits that the present invention is not obvious in view thereof.

Indeed, Hertz teaches a visual bar code recognition method which combines conventional decoding techniques with optical character recognition. From these two decodings, Hertz determines the identity of the object based on bar code recognition and verifies this identity by comparing the physical characteristics of the object from the image with the known features of the product. Hertz Abstract.

He discloses an RFID reader and imaging system that verifies the identity of an object by comparing the acquired image data or other data associated with the imaged object with the stored image data or other stored data corresponding with the RFID code read. He Abstract. Specifically, a “query module queries the database for retrieving image data corresponding to the one or more RFID codes, and accesses and/or retrieves stored data . . . that matches each received RFID code.” He, para. 54.

Neither Hertz nor He, nor any other cited reference, considered alone or in combination, discloses or suggests an apparatus or system that relies on a visual characteristic to identify an object, and then verifies the identity based on the coded identifier as presently claimed. Indeed, the cited references teach a code-based system rather than a visual characteristic-based system, where an initial identification of a product depends on the coded identifier rather than on physical characteristics of the product. Where the coded identifier initially read is inaccurate, all visual characteristic

results stemming therefrom will also be inaccurate, thereby exacerbating unreliable product identification.

Hertz explicitly teaches that the identity of a product is determined from electronic bar code identification and optical character recognition. Hertz then “verifies this identity by comparing the physical characteristics of the object from the image with the known features of the product.” Hertz Abstract. Similarly, He teaches “querying a database for accessing stored data corresponding to a stored RFID code which matches the received RFID code; and comparing the received image data with the accessed stored data for determining whether the received image data corresponds to the received RFID code.” He, p.2, para. 13. Both Hertz and He thus rely on a coded identifier as a primary search criterion, from which visual characteristics are evaluated to verify the identity of the product purchased. As discussed previously, this method of product identification is inherently unreliable as it only presents a verifiable product identification based on the coded identifier, which may be entirely inaccurate.

Further, He teaches away from the present invention by emphasizing that in RFID technology, the “ability of the RFID reader to read a tag from an object while the object is typically located remote from the reader [renders it] very possible that the reader might read a tag associated with an object that was not intended to be processed by the reader, resulting in a faulty read.” He, p. 2, para. 8. He thus presupposes that each coded identifier accurately identifies the product on which it is placed. Accordingly, one skilled in the art would not be motivated by He to use a visual characteristic as a primary search criterion, where the problem solved therein is not that of mismatched coded identifiers, but of inaccurate reads of properly affixed coded identifiers. As the process of using the

coded identifier as a primary search criterion to be verified by a visual characteristic is much simpler than the reverse process, and as the reverse process is not needed to solve the problem addressed by He, one skilled in the art would not be motivated by He to use a visual characteristic as a primary search criterion as presently claimed.

In light of the foregoing, Applicant respectfully submits that the inability of the combined references to produce Applicant's invention, and the failure of the references to disclose or suggest each of the present limitations renders the present invention non-obvious in view thereof. Further, as claims 2-8, 10-12, 14-15, 17-23, 25-26, and 28-30 further depend from otherwise allowable subject matter, such claims are also not obvious in view of the cited references.

Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 1-30 under Section 103(a) as obvious in view of the cited references.

### CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 23 day of November, 2004.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Brian C. Kunzler', with a stylized flourish at the end.

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